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10/016,963

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EXAMINER

RIOUX, JAMES A

ART UNIT

PAPER NUMBER

3694

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/016,963

Applicant(s)

LANG, DAVID A.

Examiner

James Rioux

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 - 20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1 - 20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 April 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

DETAILED ACTION

1. Claims 1 through 20 have been examined in the patent application numbered 10/016963 by Lang (hereinafter referred to as the Application).

Drawings

2. The Drawings (Fig. 1 to Fig. 5B on 8 sheets) submitted by the applicant were received on April 18, 2002. These Drawings are not acceptable, because they are not in compliance with the following titled paragraphs of 37 CFR 1.84:

(t) Numbering of Sheets of Drawings --- is required as per the statute, which states: "The number of each sheet should be shown by two Arabic numerals placed on either side of an oblique line, with the first being the sheet number and the second one being the total number of sheets of drawings, with no other marking."

3. Appropriate correction is required per 37 CFR 1.85, i.e. the Figures need to be numbered sequentially in order of Arabic numerals without A and B designations.

4. The Drawings (Fig. 1 to Fig. 5B on 8 sheets) submitted by the applicant were received on April 18, 2002. These Drawings are not acceptable, because they are not in compliance with the following titled paragraphs of 37 CFR 1.84 (i)

(i) Arrangement of views . One view must not be placed upon another or within the outline of another. All views on the same sheet should stand in the same direction and, if possible, stand so that they can be read with the sheet held in an upright position. If views wider than the width of the sheet are necessary for the clearest illustration of the invention, the sheet may be turned on its side so that the top of the sheet, with the appropriate top margin to be used as the heading space, is on the right-hand side. Words must appear in a horizontal, left-to-right fashion when the page is either upright or turned so that the top becomes the right side, except for graphs utilizing standard scientific convention to denote the axis of abscissas (of X) and the axis of ordinates (of Y).

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5. Appropriate correction is required per 37 CFR 37 CFR 1.84 (i), i.e. Fig. 4A through 4D need to be rotated 90 degrees counter-clockwise as was done with Fig. 5A & B.

6. The drawings are objected to because Fig. 1, SUBSCRIBER TERMINA; 12 is misspelled and should be spelled TERMINAL. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

7. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: the specification refer to network 10 or to item 12' on pages 14 and 16 that

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are not shown in Fig. 1. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

8. The disclosure is objected to because of the following informalities: the specification on page 15, line 10 has a misspelling of "32and". Appropriate correction is required.

9. 35 U.S.C. 112, first paragraph, requires the specification to be written in "full, clear, concise, and exact terms." The specification is replete with terms which are not clear, concise and exact. The specification should be revised carefully in order to comply with 35 U.S.C. 112, first paragraph. Examples of some unclear, inexact or verbose terms used in the specification are: numerous typographical errors that make it impossible to understand the Detailed Description of the Drawings because the reference numbers are neither consistently used in the specification nor match the figures in the Drawings. A complete review and appropriate editing is required by the applicant of the specification.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10. Claims 1-20 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The numerous errors in the reference numbers in the specification that refer to the drawings make it impossible to understand the "Hardware Configuration" described in the specification on starting on page 14 because the reference numbers are neither consistently used in the specification nor match the figures in the drawings.

11. A disclosure in an application, to be complete, must contain such description and details as to enable any person skilled in the art or science to which the invention pertains to make and use the invention as of its filing date. In re Glass, 492 F.2d 1228, 181 USPQ 31 (CCPA 1974).

12. Here, a person skilled in the art would not be able to make or use the invention because the specification is so deficient that the specification is incomprehensible since the majority of the reference numbers in the specification do not correspond to the reference numbers in the drawings nor are the references consistently used within the specification. For example, on page 16 of the specification, the application refers to reference number 10 in the drawings as subscribers 10, network 10, and network 100

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which is neither consistent in the specification or the drawings. Therefore, the specification is so deficient that it fails to meet the enablement requirements of 112, first paragraph.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

13. Claim 5 - 7, 10 - 15, and 20 rejected under 35 U.S.C. 102(e) as being anticipated by Purcell, US Patent Application Publication Number US 2001/0034680 A1 (hereinafter Purcell).

14. Here, **claim 5** is rejected under 102(e) as being anticipated by Purcell because Purcell describes the “EDT system can provide a variety of additional information to the Issuer” which is comparable to an “active investing network comprising: a plurality of subscriber [element b] **terminals** adapted to provide access to the [element a] **network** by respective subscribers; common communication services adapted to receive and display documents and messages from and among subscribers; a chief terminal adapted to generate control commands to [element c] **monitor and moderate** said communication services; said chief terminal, communication services and subscriber terminals being constructed and arranged to provide exchange of [element d]

information about investments or securities” in the Application. See Purcell

Paragraph [0048]. See Also Purcell, [element a] Claim 3 and Paragraph [0022]; [element b] Paragraph [0030]; [element c] Paragraph [0048]; [element d] Paragraph [0027], [0029], and [0048].

15. Here, **claim 6** is rejected under 102(e) as being anticipated by Purcell because Purcell describes the “networks connected to the Internet” which is comparable to “a bridge adapted to exchange information with an external agent” in the Application. See Purcell Paragraph [0022] and [0025].

16. Here, **claim 7** is rejected under 102(e) as being anticipated by Purcell because Purcell describes the “record keeping of online activities” which is comparable to an “module adapted to monitor total assets of said subscribers associated with a security issuer and to determine if a set of rules require a governmental filing regarding said security issuer” in the Application. See Purcell Claim 6 . The condition, if a set of rules require a governmental filing, is interpreted not to occur, i.e. no filing is required. Therefore, claim 7, due to the conditional statement, is interpreted to do the “do nothing” option.

17. Here, **claim 10** is rejected under 102(e) as being anticipated by Purcell because Purcell describes the “E-Brokers...enable investment trading online...that the inventive system can access” which is comparable to an “a bridge to an external agent” where external agent is described in the specification on page 12 as a data store outside the processes shown in the Application. See Purcell Paragraph [0025]; Paragraph [0022], and Paragraph [0001].

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18. Here, claim 11 is rejected under 102(e) as being anticipated by Purcell because Purcell describes the “shares will automatically be tendered” which is comparable to an “said bridge is adapted to provide securities transactions between said subscribers and said external agent” in the Application. See Purcell Paragraph [0051-52]; Paragraph [0022-25].

19. Here, claim 12 is rejected under 102(e) as being anticipated by Purcell because Purcell describes the “[i]nvestor system can be a personal computer...or any other equivalent (e.g. Palm Pilot....)” which is comparable to an “observer terminals to accommodate observers that can observe data on said system but cannot participate in active investing transactions” in the Application. See Purcell, Paragraph [0025].

20. Here, claim 13 is rejected under 102(e) as being anticipated by Purcell because Purcell describes the “EDT system can provide a variety of additional information to the Issuer” which is comparable to an “providing a plurality of subscriber [element a] terminals adapted to exchange information over a standard communication system; providing common communication services adapted to [element b] receive and display messages from and among said subscribers regarding specific securities; and providing a chief terminal adapted to [element c] monitor and moderate said messages of said communication services” in the Application. See Purcell Paragraph [0048]. See Also Purcell [element a] Paragraph [0030], [element b] Claims 8 & 1; Paragraph [0001], [element c] Paragraph [0048].

21. Here, claim 14 is rejected under 102(e) as being anticipated by Purcell because Purcell describes the “EDT system can provide a variety of additional information to the

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Issuer” which is comparable to an “obtaining additional information regarding securities by said chief terminal and transmitting said additional information from and among subscribers” in the Application. See Purcell Paragraph [0048]. See Also Purcell Paragraph [0050].

22. Here, **claim 15** is rejected under 102(e) as being anticipated by Purcell because Purcell describes the “EDT system...remotely monitor the progress” which is comparable to the “monitoring assets of said subscribers associated with a particular investment security to determine if a set of rules are applicable to said assets” in the Application. See Purcell, Paragraph [0048] and Claim 6.

23. Here, **claim 20** is rejected under 102(e) as being anticipated by Purcell because Purcell describes the “E-brokers databases that the inventive system can access” which is comparable to a “performing investment transactions by said subscribers through an external agent” in the Application. See Purcell Paragraph [0025].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

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2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

24. Claim 1 - 4, 8 - 9, and 16 - 19 rejected under 35 U.S.C. 103(a) as being unpatentable over Purcell, US Patent Application Publication Number US 2001/0034680 A1 (hereinafter Purcell), in view of U.S. Securities and Exchange Commission, EDGAR Filer Information: Electronic Filing and the EDGAR System: A Regulatory Overview, November 14, 2000, pages 1 – 3 (hereinafter SEC) and, further in view of Kevin J. Merz and Joseph Rosen, The Handbook of Investment Technology: A State-of-the-Art Guide to Selection, Implementation & Utilization, McGraw-Hill, p. 168 (hereinafter Merz).

25. Here, **claim 1** is rejected under 35 U.S.C. 103(a) as obvious over Purcell in view of SEC and, further in view of Merz. Here, Purcell teaches or discloses a “[c]omputer networks connect to the Internet” which is comparable to a “network for gathering and processing information between multiple subscribers through a communication network” in the Application. See Purcell, Paragraph [0022], Paragraph [0001], and Claim 3. Furthermore, Purcell teaches or discloses a “Investor system can be...PC or any other equivalent” which is comparable to “ a plurality of terminals, each terminal being associated with a subscriber and connected to said communication network ;and a chief workstation associated with the communication network and adapted to selectively provide a plurality of services to subscribers through said terminals” in the Application. See Purcell, Paragraph [0030]. In addition, Purcell teaches or discloses “the EDT system” for tender offers which is comparable to “a security transaction” in the Application. See Purcell, Paragraph [0051-52]. A “tender offer” is a type of “security

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transaction” because a tender offer is the buying of shares of stock of a company. See Jon Downes and Jordan Elliot Goodman, Dictionary of Finance and Investment Terms, Barron's Educational Series, Inc., 6th ed., pages 725-726 (used to define term used in Purcell patent). Finally, Purcell teaches or discloses “information exchange between subscribers” See Purcell, Paragraph [0031-32].

26. However, Purcell does not teach or disclose a “preparation of a public filing” as proposed in the Application. On the other hand, the SEC teaches or discloses that “Filers who choose to use HTML” in the EDGARS system. See SEC, p.1 – 3.

Additionally, Merz teaches or discloses “a compliance module...for alerting the trader or portfolio manager of possible violations” of SEC laws. See Merz, p. 168.

27. The prior art of Purcell and SEC are “analogous” or “pertinent” because Purcell solves the same problem stockholders communicating with one another for corporate governance and the SEC solves the same problem of public communication of information with its EDGARS system. Both Purcell and SEC are in the same field of endeavor as the patent application because all references are in the field of “securities.”

28. The prior art of Purcell and Merz are “analogous” or “pertinent” because Purcell solves the same problem stockholders communicating with one another for corporate governance and Merz solves the same problem of communication of information to the public. Both Purcell and Merz are in the same field of endeavor as the patent application because all references are in the field of “securities.”

29. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Purcell to include SEC filings on the internet

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in view of SEC's EDGARS public filing system because the SEC EDGARS system simply automates filings since the need to "enhance the speed and efficiency of SEC processing" as stated in of SEC. See SEC, page 1. It would have been obvious to one skilled in the art to use the improved filing system in SEC to increase the processing speed in the system of Purcell because Purcell would need or want to comply with the SEC filing procedures.

30. Furthermore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify SEC's EDGARS system to include a "compliance module" in view of Merz because Merz would automatically ensure compliance with the SEC by adding the automatic subroutine to Purcell since the need to "facilitate regulatory reporting" as stated in of Merz. See Merz, p. 168. It would have been obvious to one skilled in the art to use the compliance module in Merz to comply with the EDGARS system of the SEC because the SEC would need or want the filings to be done automatically. It is not 'invention' to broadly provide a mechanical or automatic means to replace manual activity which has accomplished the same result. In re Venner, 120 USPQ 192 (CCPA 1958).

31. Here, **claim 2** is rejected under 35 U.S.C. 103(a) as obvious over Purcell in view of SEC and, further in view of Merz. Here, Purcell teaches or discloses a computer network including securities trading as discussed above in claim 1. See discussion of claim 1 above.

32. However, Purcell does not teach or disclose a way to "prepare and deliver said public filling through said communication network" as proposed in the Application. On

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the other hand, the SEC teaches or discloses that "Filers who choose to use HTML" in the EDGARS system. See SEC, p.1 – 3. Additionally, Merz teaches or discloses "a compliance module...for alerting the trader or portfolio manager of possible violations" of SEC laws. See Merz, p. 168.

33. The prior art of Purcell and SEC are "analogous" or "pertinent" because Purcell solves the same problem stockholders communicating with one another for corporate governance and the SEC solves the same problem of public communication of information with its EDGARS system. Both Purcell and SEC are in the same field of endeavor as the patent application because all references are in the field of "securities."

34. The prior art of Purcell and Merz are "analogous" or "pertinent" because Purcell solves the same problem stockholders communicating with one another for corporate governance and Merz solves the same problem of communication of information to the public. Both Purcell and Merz are in the same field of endeavor as the patent application because all references are in the field of "securities."

35. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Purcell to include preparation and delivery of SEC filings on the internet in view of SEC's EDGARS public filing system because the SEC EDGARS system simply automates filings since the need to "enhance the speed and efficiency of SEC processing" as stated in SEC. See SEC, page 1. It would have been obvious to one skilled in the art to use the improved filing system in SEC to increase the processing speed in the system of Purcell because Purcell would need or want to comply with the SEC filing procedures.

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36. Furthermore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify SEC's EDGARS system to include a "compliance module" in view of Merz because Merz would automatically ensure compliance with the SEC by adding the automatic subroutine to Purcell since the need to "facilitate regulatory reporting" as stated in of Merz. See Merz, p. 168. It would have been obvious to one skilled in the art to use the compliance module which prepares SEC filings in Merz to comply with the EDGARS system of the SEC because the SEC would need or want the filings to be done automatically. It is not 'invention' to broadly provide a mechanical or automatic means to replace manual activity which has accomplished the same result. In re Venner, 120 USPQ 192 (CCPA 1958).

37. Here, claim 3 is rejected under 35 U.S.C. 103(a) as obvious over Purcell in view of SEC and, further in view of Merz. Here, Purcell teaches or discloses a computer network including securities trading as discussed above. See discussion of claim 1 above.

38. However, Purcell does not teach or disclose "wherein said communication network is connected to at least one external agent, and wherein said chief workstation is adapted to obtain information from said external agent and deliver said information to said terminals" as proposed in the Application. On the other hand, the Purcell teaches or discloses that "E-brokers databases that the inventive system can access". See Purcell, paragraph [0025].

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39. The prior art of Purcell and SEC are “analogous” or “pertinent” as discussed previously in claim 1 above. The prior art of Purcell and Merz are “analogous” or “pertinent” as discussed previously in claim 1 above.

40. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Purcell to the SEC’s EDGARS public filing system as discussed above in claim 1. Furthermore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify SEC’s EDGARS system to include a “compliance module” in view of Merz as discussed above in claim 1.

41. Here, claim 4 is rejected under 35 U.S.C. 103(a) as obvious over Purcell in view of SEC and, further in view of Merz. Here, Purcell teaches or discloses a computer network including securities trading as discussed above. See discussion of claim 1 above.

42. However, Purcell does not teach or disclose “wherein said communication network is connected to an external agent adapted to perform electronic security transactions, wherein said chief workstation is adapted to enable security transactions by said subscribers through said external agents” as proposed in the Application. On the other hand, the Purcell teaches or discloses that “E-brokers databases that the inventive system can access”. See Purcell, paragraph [0025].

43. The prior art of Purcell and SEC are “analogous” or “pertinent” as discussed previously in claim 1 above. The prior art of Purcell and Merz are “analogous” or “pertinent” as discussed previously in claim 1 above.

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44. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Purcell to the SEC's EDGARS public filing system as discussed above in claim 1. Furthermore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify SEC's EDGARS system to include a "compliance module" in view of Merz as discussed above in claim 1.

45. Here, claim 8 is rejected under 35 U.S.C. 103(a) as obvious over Purcell in view of Merz. Here, Purcell teaches or discloses an "[c]omputer networks connected to the Internet." See Purcell, Paragraph [0022]; Claim 3. Purcell also teaches or discloses an "[i]nvestor system can be a personal computer...or any other equivalent (e.g. Palm Pilot....)" See Purcell, Paragraph [0025]. In addition, Purcell teaches or discloses an "EDT system...remotely monitor the progress." See Purcell, Paragraph [0048]. Finally, Purcell teaches or discloses an "information may include the digital documents ...,which may be electronically captured from the EDGAR database." See Purcell, Paragraph [0027-29]; Paragraph [0048].

However, Purcell does not teach or disclose a "wherein said compliance module is further adapted to generate a filling document based on said total assets and said set of rules" as proposed in the Application. On the other hand, Merz teaches or discloses that "[t]he compliance module requires a message or process for alerting the trader or portfolio manager of possible violations of defined rules." See Merz, p. 168.

The prior art of Purcell and Merz are "analogous" or "pertinent" because Purcell solves the same problem providing communications between shareholders and Merz

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solves the same problem of ensuring compliance of shareholder with SEC regulations. Both Purcell and Merz are in the same field of endeavor as the patent application because Purcell and Merz are in the field of "securities."

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Purcell to include a "compliance module" in view of Merz because Merz would automatically ensure compliance with the SEC by adding the automatic subroutine to Purcell since the need to "facilitate regulatory reporting" as stated in of Merz. See Merz, p. 168. It would have been obvious to one skilled in the art to use the compliance module in Merz to comply with the EDGARS system of the SEC because the SEC would need or want the filings to be done automatically since the EDGARS system is already incorporated into the Purcell patent application by reference. It is not 'invention' to broadly provide a mechanical or automatic means to replace manual activity which has accomplished the same result. In re Venner, 120 USPQ 192 (CCPA 1958).

46. Here, claim 9 is rejected under 35 U.S.C. 103(a) as obvious over Purcell in view of SEC. Here, Purcell teaches or discloses a computer network including monitoring of the communication of investment information as discussed above in claim 8. See discussion of claim 8 above.

47. However, Purcell does not teach or disclose "a bridge adapted to deposit said document with a governmental agency" as proposed in the Application. On the other hand, the SEC teaches or discloses that "Filers who choose to use HTML" in the EDGARS system which is already incorporated into the Purcell patent application by

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reference. See SEC, p.1 – 3. However, Purcell only specifically incorporated the obtaining of documents through the SEC's EDGARS system and not the filing of documents with the SEC through the EDGARS system.

48. The prior art of Purcell and SEC are "analogous" or "pertinent" because Purcell solves the same problem stockholders communicating with one another for corporate governance and the SEC solves the same problem of public communication of information with its EDGARS system. Both Purcell and SEC are in the same field of endeavor as the patent application because all references are in the field of "securities."

49. Therefore, it would have been very obvious to a person of ordinary skill in the art at the time the invention was made to modify Purcell to include SEC filings on the internet in view of SEC's EDGARS public filing system which was already part of Purcell because the SEC EDGARS system simply automates filings since the need to "enhance the speed and efficiency of SEC processing" as stated in of SEC. See SEC, page 1. It would have been obvious to one skilled in the art to use the improved filing system in SEC to increase the processing speed in the system of Purcell because Purcell would need or want to comply with the SEC filing procedures. It is not 'invention' to broadly provide a mechanical or automatic means to replace manual activity which has accomplished the same result. In re Venner, 120 USPQ 192 (CCPA 1958).

50. Here, **claim 16** is rejected under 35 U.S.C. 103(a) as obvious over Purcell in view of Merz. Here, Purcell teaches or discloses an "[i]nvestor system can be a personal computer...or any other equivalent (e.g. Palm Pilot....)" See Purcell, Paragraph [0025]. Purcell also teaches or discloses an "an investor system for an

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Investor to send and receive information" regarding stocks. See Purcell Claims 8 & 1; Paragraph [0001]. Finally, Purcell teaches or discloses an "EDT system...remotely monitor the progress" which". See Purcell, Paragraph [0048] and Claim 6.

51. However, Purcell does not teach or disclose an "a compliance module to determine if said set of rules are applicable" as proposed in the Application. On the other hand, Merz teaches or discloses that "a compliance module...for alerting the trader or portfolio manager of possible violations" of SEC laws. See Merz, p. 168.

52. The prior art of Purcell and Merz are "analogous" or "pertinent" because Purcell solves the same problem stockholders communicating with one another for corporate governance and Merz solves the same problem of communication of information to the public. Both Purcell and Merz are in the same field of endeavor as the patent application because all references are in the field of "securities."

53. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify SEC's EDGARS system to include a "compliance module" in view of Merz because Merz would automatically ensure compliance with the SEC by adding the automatic subroutine to Purcell of filing since the need to "facilitate regulatory reporting" as stated in Merz. See Merz, p. 168. It would have been obvious to one skilled in the art to use the compliance module in Merz to comply with the EDGARS system of the SEC because the SEC would need or want the filings to be done automatically. It is not 'invention' to broadly provide a mechanical or automatic means to replace manual activity which has accomplished the same result. In re Venner, 120 USPQ 192 (CCPA 1958).

54. Here, claim 17 is rejected under 35 U.S.C. 103(a) as obvious over Purcell in view of Merz. Here, Purcell teaches or discloses a computer network including automated compliance module for SEC filings as discussed above in claim 16. See discussion of claim 16 above. Here, Purcell also teaches or discloses a "E-brokers databases that the inventive system can access." See Purcell Paragraph [0025].

55. However, Purcell does not teach or disclose "generating a filing document when said set of rules are applicable" as proposed in the Application. On the other hand, Merz teaches or discloses that "a compliance module...for alerting the trader or portfolio manage of possible violations" of SEC laws. See Merz, p. 168.

56. The prior art of Purcell and Merz are "analogous" or "pertinent" because Purcell solves the same problem stockholders communicating with one another for corporate governance and Merz solves the same problem of communication of information to the public. Both Purcell and Merz are in the same field of endeavor as the patent application because all references are in the field of "securities."

57. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to Purcell to include a compliance module in view of Merz because Merz adds the subroutine of automatic legal compliance since the need to "facilitate regulatory reporting" as stated in of Merz. See Merz, page 168. Therefore, it would have been obvious to one skilled in the art to use the compliance module in Merz to generate filing documents for the EDGARS system of the SEC because the SEC would need or want the filings to be done automatically. It is not 'invention' to

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broadly provide a mechanical or automatic means to replace manual activity which has accomplished the same result. In re Venner, 120 USPQ 192 (CCPA 1958).

58. Here, **claim 18** is rejected under 35 U.S.C. 103(a) as obvious over Purcell in view of Merz. Here, Purcell teaches or discloses a computer network including automated compliance module for SEC filings as discussed above in claim 16. See discussion of claim 16 above.

59. However, Purcell does not teach or disclose “depositing said filing document with a receiving agency” as proposed in the Application. On the other hand, the SEC teaches or discloses that “Filers who choose to use HTML” in the EDGARS system. See SEC, p.1 – 3.

60. The prior art of Purcell and SEC are “analogous” or “pertinent” because Purcell solves the same problem stockholders communicating with one another for corporate governance and the SEC solves the same problem of public communication of information with its EDGARS system. Both Purcell and SEC are in the same field of endeavor as the patent application because all references are in the field of “securities.”

61. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Purcell to include deposit SEC filings in view of SEC's EDGARS public filing system because the SEC EDGARS system simply automates the deposit of filings since there is the need to “enhance the speed and efficiency of SEC processing” as stated in of SEC. See SEC, page 1. It would have been obvious to one skilled in the art to use the improved filing system in SEC to

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increase the processing speed in the system of Purcell because Purcell would need or want to comply with the SEC filing procedures.

62. Here, claim 19, is rejected under 103 as being anticipated by Purcell in view of SEC because that claim repeats the same language as claim 18 with the exception of "filling document electronically" which has already been address in the discussion of claim 18. Therefore, claim 19 is rejected under the same rationale as claim 18 described above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Rioux whose telephone number is (571) 272-7326. The examiner can normally be reached on Monday through Friday from 8:30 AM to 5:00 PM..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


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